

Atty. Docket: 6173/07US

Obviousness Rejection

The grounds for the obviousness rejection of claims 1-3, 6-16 and 19-29 is set forth in part 3 on pages 2-5 of the Office Action. Specifically, the rejection asserts that the claims are rendered obvious by U.S. Patent Application Publication No. 2001/0046877 to Ohkubo et al in view of U.S. Patent No. 6,650,905 to Toskala et al (hereinafter referred to as the '905 patent). Applicants respectfully traverse the obviousness rejection because the '905 patent is not prior art to this application and because the rejection fails to establish a prima facie case that the applied references suggest each and every one of the combination of limitations recited in the rejected claims.

First, it is noted that the '905 patent was not issued until after the February 19, 2002 filing date of this application and is also assigned to Nokia, the assignee of this application, the assignment of this application having been duly recorded at Reel 012927/0713. The '905 patent was not published prior to the filing date of this application and would not be prior art except under 35 USC 102(e). Consequently, the '905 patent is not available for use as prior art in an obviousness rejection. See 35 USC 103(c) and MPEP 706.06(l)(1).

However, even if the '905 patent could be available for use as prior art, the rejection still does not establish a prima facie case of obviousness. Independent claims 1, 15 and 23 each recite the features related to measuring the power level of a signal received by user equipment and comparing the power level measured by the user equipment to power level information indicated by power level information provided in a transmitted channel received by a user equipment. The obviousness rejection relies primarily upon the second preferred embodiment illustrated in Figs. 2 and 3 and described at paragraphs 0046 to 0066 of U.S. Patent Application Publication No.

Atty. Docket: 6173/07US

2001/0046877 to Ohkubo et al (for convenience this embodiment is hereafter referred to simply as "Ohkubo"). As explained previously in the response to the anticipation rejection based on Ohkubo in the first office Action, although Ohkubo addresses the problem of power level control for a multicast signal in a wireless system, it does not include both of the features related to measuring the power level of a signal received by user equipment and comparing the power level measured by the user equipment to power level information indicated by power level information provided in a transmitted channel received by a user equipment.

The mobile station in Ohkubo contains C/I measurement unit 421, comparator 43, and reference value (Rref) 44. However, unlike the claims, the comparator 43 in Ohkubo does not compare a measured power level of a received signal to power level information in a transmitted channel. Instead, it compares the measured C/I ratio value to a reference C/I ratio. There is no indication that reference value Rref is provided in a transmitted channel (see paragraph 0049 and 0053). Indeed, these features of Ohkubo are contrasted with the first embodiment described in the '877 patent application (see paragraphs 0048 and 0049), which is mutually exclusive of Ohkubo in some respects. Consequently, Ohkubo does not include or suggest the feature of comparing the power level measured by the user equipment to power level information indicated by power level information provided in a transmitted channel received by a user equipment as recited in the independent claims. As explained above, the reference value Rref is not provided in a transmitted channel.

Also, applicants additionally submit that the claimed invention is not obvious even when considering Ohkubo in view of the '905 patent. First, it is not even understood how the rejection

¹ The Office Action refers to "measuring (62)" but this appears to be a mistaken reference to measurement unit 42.

Atty. Docket: 6173/07US

proposes to combine Ohkubo and the '905 patent. The rejection states that the '905 patent "teaches measuring power level at the user's equipment", but the rejection asserts that Ohkubo also includes this feature. So even if the statement was true, the '905 patent appears to be merely cumulative of Ohkubo rather than providing any additional teaching. The rejection further states that the modification of Ohkubo would be obvious "in order to transmit to the base station the measured value as feedback for the base station to adjust its power level." However, the rejection asserts that Ohkubo also sends power level measurement information to the base station, so it is not seen how Ohkubo would be modified due to this consideration.

Applicants respectfully submit that the rejection fails to identify any motivation in the '905 patent why one of ordinary skill in the art would seek to modify Ohkubo. The '905 patent is directed to power control of a downlink shared channel (DSCH) and notes disadvantages with two prior art alternatives (see col. 4, lines 18-57). However, Ohkubo does not correspond to any of the identified disadvantageous prior arts. Although the embodiments described in the '905 patent may contain certain related features, there does not appear to be any reason for one of ordinary skill in the art to modify Ohkubo to include certain features of the '905 patent other than the hindsight provided by this application.

Claims 2 and 16

Claims 2 and 16 are each dependent claims additionally reciting that the method is carried out when the user equipment enters a new cell. The rejection asserts that Ohkubo would be modified to include such a feature since the power measurement in Fig. 10 of the '905 patent takes place when the user equipment enters a new cell. However, the referenced measurement in

Atty. Docket: 6173/07US

the '905 patent relates to a soft handover and there is no reason why one of ordinary skill in the art would attempt to apply it to Ohkubo.

Claim 11

Claim 11 is a dependent claim additionally reciting that the message sent by the user equipment does not cause the establishment of an RRC connection. The rejection asserts that because the '905 patent includes network controller 76, one of ordinary skill in the art would modify Ohkubo to include the feature of claim 11. However, Ohkubo also includes a network controller and, in any event, the presence of a network controller does not affect whether or not an RRC connection is established in a power control method. Again, there is no reason for one of ordinary skill in the art to modify Ohkubo as suggested because of the '905 patent.

Claims 14 and 26

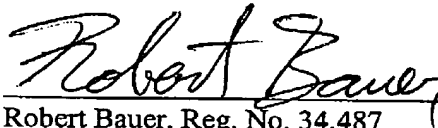
Claims 14 and 26 are dependent claims additionally reciting tracking the location of user equipment. Applicants respectfully traverse the assertion that Ohkubo includes this feature as they are unable to find any disclosure of location tracking and no disclosure is cited in the rejection.

Reconsideration and withdrawal of the rejection is respectfully requested in view of the foregoing remarks. It is submitted that all of the rejected claims are allowable over the applied references for at least the reasons set forth above. It is respectfully requested that a Notice of Allowance be promptly mailed.

Atty. Docket: 6173/07US

The Commissioner is hereby authorized to charge any fees necessary for the consideration of this Response, or to credit any overpayment, to the undersigned attorney's Deposit Account No. 02-4270 (Dkt. No. 6173-07US).

Respectfully Submitted,

A handwritten signature in cursive script, reading "Robert Bauer", is written over a horizontal line.

Robert Bauer, Reg. No. 34,487
BROWN RAYSMAN MILLSTEIN FELDER &
STEINER LLP
900 Third Avenue
New York, NY 10022
Tel: (212) 895-2000
Fax: (212) 895-2600